

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Donald R. Youell, Jr. et al.

Appeal 2007-2477
Application 09/865,229
Technology Center 3700

Decided: August 10, 2007

Before ADRIENE LEPIANE HANLON, SALLY C. MEDLEY, AND
MICHAEL P. TIERNEY, *Administrative Patent Judges*.

TIERNEY, *Administrative Patent Judge*.

DECISION ON APPEAL

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This is a 35 U.S.C. § 134 appeal in the above-referenced case¹ of claims 1-5 and 24. Claims 6-23 are withdrawn from consideration as being directed to a non-elected invention and are not on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

¹ The real party in interest is Donald R. Youell, Jr. and Rudy Youell. (Br. at 3).

STATEMENT OF THE CASE

Applicants' invention is directed to a method for packaging automobile parts to decrease damage during shipment.

There is only one independent claim on appeal, claim 1. Claim 1 is representative of the claims on appeal and reads as follows:

Method for packaging an automobile part to decrease damage during shipment, which comprises the steps of:

- (a) providing a paperboard having a front and a back;
- (b) placing a structural automobile part on the front of said paperboard leaving exposed areas of said front of said paperboard; and
- (c) shrink-wrapping with plastic shrink wrap material said structural automobile part to said paperboard and said exposed areas of said front of said paperboard, wherein damage to said structural automobile part is decreased during shipping.

The Examiner has set forth five (5) prior art rejections. The rejections are as follows:

- i. Claims 1 and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Meyer, U.S. Pat. 3,784,004 ("Meyer").
- ii. Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Meyer in view of Gillio-tos, U.S. Pat. 4,611,456 ("Gillio-tos").
- iii. Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Meyer in view of Engles, U.S. Pat. 3,154,898, ("Engles").
- iv. Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Meyer in view of Engles and further in view of Kean, U.S. Pat. 3,618,755 ("Kean").
- v. Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Meyer in view of Wilkinson, U.S. Pat. 6,010,003 ("Wikinson").

There are generally three issues in dispute. Specifically, Applicants and the Examiner dispute whether the prior art teaches packaging a “structural automobile part,” “shipping” the part, and decreased “damage” when shipping the part. In particular, the Examiner finds that the prior art describes packaging a clutch or various automobile parts to prevent corrosion. Applicants contend that an automobile clutch is not a structural automobile part as a clutch is not a large, heavy automobile part. Applicants also contend that the term damage does not encompass corrosion. Additionally, Applicants state their claims require the part be shipped and that the prior art describes packaging for storage as opposed to shipping.

We affirm the Examiner's rejections.

ISSUE

The issue is whether Applicants have shown that the Examiner erred in rejecting the claims. Specifically, the issue is:

Have Applicants demonstrated that the Examiner erred in rejecting the claims over a prior art reference that describes preventing corrosion by shrink wrapping metal automobile parts onto a paperboard substrate?

FINDINGS OF FACT

A. Applicants' '229 Specification and Claims

1) Applicants' claims on appeal are directed to a method of packaging an automobile part to decrease damage during shipment. (Appeal Br., Independent claim 1).

2) Applicants' specification states that even unbreakable auto parts "can become scratched, dented, and abraded to the point that rework of the part is needed." (Specification, p. 4, ll. 12-14).

B. Prior Art

1. Meyer

3) Meyer describes a skin packaging process comprising placing an article on a substrate of porous or air-permeable material and coating it with a meltable thermoplastic. (Meyer, Abstract and claim 1).

4) Meyer describes its substrate as a conventional corrugated paperboard material or other porous paperboard material. (*Id.* at col. 3, line 63 to col. 4, line 3).

5) Meyer states that its protective barrier coating protects metal products, such as bearings, clutches or various automobile or mechanical parts against corrosion. (*Id.* at col. 5, ll. 39-43).

2. Gillio-tos

6) Gillio-tos describes a method for packing products in an air-impermeable enclosure. (Gillio-tos, Abstract).

7) Gillio-tos teaches that it was known in the packaging art to employ laminated multilayer materials as a packaging substrate. (*Id.* at col. 3, ll. 16-20).

3. Engles

8) Engles teaches that it was known in the art to package auto parts, such as spark plugs. (Engle, Example 1).

4. Kean

9) Kean describes a method of packaging glass sheets to protect against breakage and weathering during transportation or storage. (Kean, Abstract).

5. Wilkinson

10) Wilkinson describes shrink wrapping pallets for packages. (Wilkinson, Abstract).

11) The Examiner found, and Applicants do not dispute, that Wilkinson teaches that it is old and well known in the art to place a shrink wrapped object into a container for the purposes of protecting the object during shipment. (Examiner's Answer, p. 6, Br. at 17).

C. Declarations of Donald Youell

12) Applicants' brief relies upon the declaration and supplemental declaration of Mr. Youell, a named inventor of the application on appeal. (Br., Evidence Appendix).

13) Mr. Youell declares that he has been involved in the manufacture and design of corrugated packaging for 45 years. (Declaration, ¶ 2).

1 14) Mr. Youell testifies that his customers have informed him that the
2 claimed method has considerably reduced glass product breakage. (*Id.* at ¶¶
3 8-17).

4
5 15) Mr. Youell testifies that his specification defines a structural
6 automobile part as a large and heavy automobile part, which may be
7 breakable or unbreakable. (*Id.* at ¶ 23).

8
9 16) Mr. Youell testifies that “Meyer includes no suggestion or teaching to
10 package and ship structural automobile parts.” (*Id.* at ¶ 25).

11
12 17) Mr. Youell testifies that shipping window glass, door panels, hoods
13 and fenders are not equivalent to or interchangeable with shipping clutches
14 and bearings. (*Id.* at ¶ 29).

15
16 18) Mr. Youell testifies that he would not look to Meyer or any other
17 references dealing with presence or absence of moisture to solve the problem
18 that he faced. (Supplemental Declaration, ¶ 9).

PRINCIPLES OF LAW

The United States Patent & Trademark Office is tasked with interpreting claims as broadly as their terms reasonably allow. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Indeed, *Zletz* held that the Board erred in reading unwritten limitations into claims on appeal and stated that it was incorrect for the Board to construe claims narrowly, such as done in courts confronting issues of infringement and validity.

Anticipation under 35 U.S.C. § 102 is a question of fact. *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros.Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Additionally, an invention is not patentable under 35 U.S.C. § 103 if it is obvious. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1745-46, 82 USPQ2d 1385, 1400 (2007). The facts underlying an obviousness inquiry include:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966). In addressing the findings of fact, “[t]he combination of familiar elements according to known

1 methods is likely to be obvious when it does no more than yield predictable
2 results.” *KSR* at 1739, 82 USQP2d at 1395. As explained in *KSR*:

3 If a person of ordinary skill can implement a predictable
4 variation, §103 likely bars its patentability. For the same
5 reason, if a technique has been used to improve one device, and
6 a person of ordinary skill in the art would recognize that it
7 would improve similar devices in the same way, using the
8 technique is obvious unless its actual application is beyond his
9 or her skill. *Sakraida* and *Anderson's-Black Rock* are
10 illustrative — a court must ask whether the improvement is
11 more than the predictable use of prior art elements according to
12 their established functions.

13
14 *KSR* at 1740, 82 USPQ2d at 1396. As recognized in *KSR*, “[a] person of
15 ordinary skill is also a person of ordinary creativity, not an automaton.”
16 *KSR* at 1742, 82 USPQ2d at 1397.

17 On appeal, Patentee bears the burden of showing that the Examiner
18 has not established a legally sufficient basis for combining the teachings of
19 the prior art. Patentee may sustain its burden by showing that where the
20 Examiner relies on a combination of disclosures, the Examiner failed to
21 provide sufficient evidence to show that one having ordinary skill in the art
22 would have done what Applicant did. *United States v. Adams*, 383 U.S. 39
23 51-52 (1966).

24 25 ANALYSIS

26 There are five (5) prior art rejections on appeal. Before addressing the
27 merits of the rejection, we construe the claim limitations that are in dispute.

1 I. Claim Construction

2 A) Shipping

3 Applicants argue that the prior art fails to describe shipping a
4 packaged automobile part. (Br. at 12). The Examiner disagrees stating that
5 the claim does not positively recite the step of shipping the packaged part.
6 (Answer at 8). The Examiner also states that shipping merely requires that
7 damage be reduced when transporting a wrapped object to an area located
8 separately from the wrapping operation. (*Id.*).

9 Applicants' claims do not require the step of shipping the packaged
10 part. Specifically, Applicants' independent claim 1 requires three steps: 1)
11 providing paperboard, 2) placing the auto part on the paperboard, and 3)
12 shrink-wrapping the part to the paperboard. Applicants' claim 5 depends
13 from claim 1 and further requires the step of placing the package in a
14 container.

15 In contrast to the positively recited steps, the term "shipping" is used
16 to refer to what would occur if the part is shipped. Specifically, the term
17 shipping and shipment are used in the preamble and wherein clause as
18 follows: "[m]ethod for packaging an automobile part to decrease damage
19 during shipment . . . wherein damage to said structural automobile part is
20 decreased during shipping." Thus, the plain language of the claims requires
21 that the claimed method results in a decrease in damage to the part if and
22 when the part is shipped. Giving Applicants' claims their broadest
23 reasonable interpretation, we conclude that the claims do not require the step
24 of shipping the packaged part.

25

1 B) Structural Automobile Part

2 Applicants and the Examiner disagree upon the interpretation of the
3 phrase “structural automobile part.” The Examiner alleges that a structural
4 automobile part is “virtually any part to be utilized on or inside an
5 automobile.” (Answer at 7). Applicants contend that a structural
6 automobile part “is defined in the specification as being a large and heavy
7 automobile part, which may be unbreakable or breakable.” (Br. at 10).

8 The dispute between the Examiner and Applicants is moot. Meyer
9 describes packaging a clutch or various automobile parts to prevent
10 corrosion. Applicants have not demonstrated that an automotive clutch is
11 outside the scope of a “large and heavy automobile part.” Additionally, one
12 skilled in the art would readily understand that Meyer’s method of
13 packaging various metal automobile parts to prevent corrosion damage
14 includes large and heavy metal automobile parts, such as hoods, fenders, etc.
15 As such, for purposes of this appeal we will adopt Applicants’ interpretation
16 and construe “structural automobile part” as encompassing any large and
17 heavy automobile part.

18
19 C) Damage

20 Applicants and the Examiner disagree on whether corrosion
21 constitutes damage to a part. The term damage normally implies decreased
22 value or usefulness of an object. Applicants’ specification identifies damage
23 as including scratches, dents and abrasions that require rework.
24 (Specification, p. 4, ll. 12-14). Just as scratches can require rework, one of
25 ordinary skill in the art would likewise understand that a corroded
26 automotive part is one that is in need of rework or replacement. Based upon
27 the plain language of the claim and the description provided by the

1 specification, we conclude that the broadest reasonable interpretation of the
2 word damage encompasses damage due to corrosion.

3

4 II. The Rejection of Claims 1 and 24 Under 35 U.S.C. § 102(b) as
5 being anticipated by Meyer

6

7 Generally, independent claim 1 is directed to a method of shrink
8 wrapping a structural automobile part onto paperboard to decrease damage
9 during shipment. Claim 24 depends from claim 1 and defines damage as
10 comprising scratching, denting, breaking, abrading and stressing.

11 Meyer describes a method of shrink wrapping metal automobile parts
12 onto paperboard to prevent corrosion damage. Meyer identifies metal
13 automobile parts as including bearings and clutches.

14 Applicants contend that Meyer fails to teach shipping the packaged
15 part. (Br. at 12). Applicants' claims however, do not require the step of
16 shipping the packaged part. Instead, Applicants' claims require that damage
17 is decreased, if and when the package part is shipped.

18 Applicants contend that Meyer does not teach prevention of damage
19 during shipment. (Br. at 11). Applicants state that Meyer is directed to
20 preventing corrosion as opposed to addressing the problem of reducing
21 physical damage. (Br. at 13). Corrosion is a form of physical damage to a
22 metal part. Accordingly, we do not credit Applicants' attorney argument
23 that Meyer fails to address physical damage prevention.

24 Applicants state that Meyer fails to teach or suggest a packaging
25 method that could protect a windshield from breaking, fenders from denting
26 or hoods from scratching. (Br. at 13). Under the principles of inherency, if
27 a prior art device in its normal and usual operation will perform Applicants'
28 claimed function, then the claim will be considered anticipated by the prior

1 art device. *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir.
2 1986). Applicants' shrink wrapping material is a plastic. (Specification, p.
3 2, ll. 32-34). Similarly, Meyer's shrink wrapping material is a meltable
4 thermoplastic. (Meyer, Abstract). Meyer describes its meltable
5 thermoplastic as forming a barrier coating. (*Id.*). As Applicants and Meyer
6 both describe a method of shrink wrapping an automobile part with plastic to
7 reduce damage, we find that Meyer's method of packaging inherently
8 reduces damage from scratching.

9 Applicants contend that Meyer's bearings, clutches, etc. are not
10 structural automobile parts as defined in Applicants' specification. (Br. at
11 12). As discussed above, Applicants state that their specification defines
12 structural automobile part as a part used in an automobile that is large and
13 heavy. (Br. at 10). Applicants have failed to provide a sufficient
14 explanation as to why a clutch is not considered a large, heavy automobile
15 part. Additionally, Meyer teaches that its shrink wrapping method is
16 applicable to any metal automobile part.

17 Applicants contend that Meyer is not in the field of the inventor's
18 endeavor. (Br. at 13). In particular, Applicants state that Meyer relates to
19 article preservation as opposed to preventing physical damage. The
20 analogous-art test articulated in Graham requires that:

21 [A] reference is either in the field of the applicant's endeavor or
22 is reasonably pertinent to the problem with which the inventor
23 was concerned in order to rely on that reference as a basis for
24 rejection.

25
26 *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1335-36 (Fed. Cir. 2006).
27 A reference is taken for all that it teaches. Meyer teaches that its method
28 decreases corrosion damage (a form of physical damage) to a metal

1 automobile part. As both Applicants and Meyer endeavor to protect parts
2 from damage from their surroundings, we conclude that Meyer is in the field
3 of the inventor's endeavor.

4 Applicants contend that the declarations of Mr. Youell evidence the
5 nonobviousness of the claimed invention. (Br. at 14). Mr. Youell's
6 declarations are said to provide evidence that his company has increased
7 sales due to the use of the claimed method stemming from a reduction in
8 glass breakage experienced by his company's customers. (*Id.*).

9 The rejection over Meyer alone is based upon anticipation not
10 obviousness. Additionally, Mr. Youell's declarations are not commensurate
11 in scope with the claimed decrease in damage to structural automobile parts,
12 which may be formed of metal, composite, glass or combinations thereof
13 and where the damage may be in the form of a dent or scratch. (See claims
14 1-5 and 24). As the secondary considerations raised in Mr. Youell's
15 declarations are not commensurate in scope with the claimed subject matter,
16 we give them little weight. *In re Harris*, 409 F.3d 1339, 1343, 74 USPQ2d
17 1951, 1955 (Fed. Cir. 2005) (Board correctly reasoned that showing of
18 unexpected results was not commensurate in scope with degree of protection
19 sought by claims).

20 Based upon the evidence presented, we find that Applicants' have
21 failed to demonstrate that the Examiner erred in finding that claims 1 and 24
22 are anticipated by Meyer.

23
24 III. The Rejection of Claim 2 Under 35 U.S.C. § 103(a) as being
25 unpatentable over Meyer in view of Gillio-tos
26

27 Applicants' claim 2 depends from claim 1 and requires that the
28 paperboard comprise laminated piles of paperboard.

1 The Examiner found that Meyer teaches all material limitations of
2 claim 2 except for the use of a laminate backing. (Answer, p. 4). The
3 Examiner found that Gillio-tos demonstrates that it was old and well known
4 in the art to use a backing that can be comprised of a laminate to increase
5 product durability. (*Id.*).

6 Applicants contend that Gillio-tos does not make up for the
7 deficiencies of Meyer. Applicants state that Gillio-tos does not describe the
8 packaging of automobile parts. (Br. at 15-16). Applicants however, do not
9 dispute the Examiner's finding that the use of laminate backing was well
10 known in the art to increase product durability.

11 Applicants' claimed method represents a combination of prior art
12 elements for their known purpose to yield predictable results. Specifically,
13 Meyer teaches a method for shrink wrapping an automobile part to
14 paperboard to prevent corrosion damage. Gillio-tos confirms that it was
15 known in the art to use a laminate backing to increase product durability.
16 One of ordinary skill in the packaging art would have been guided to employ
17 a laminate backing in the shrink wrapping method of Meyer to increase
18 package durability. We find that Applicants' improvement is no more than
19 combining prior art elements in a known manner according to their
20 established functions to achieve a predictable result, improved package
21 durability. We affirm the Examiner's rejection of claim 2 as obvious over
22 Meyer in view of Gillio-tos.

23
24 IV. The Rejection of Claim 3 Under 35 U.S.C. § 103(a) as being
25 unpatentable over Meyer in view of Engles
26

27 Applicants' claim 3 depends from claim 1 and requires that the
28 automobile part comprises metal, composite or glass.

1 Meyer describes a method of packaging a metal automotive part, such
2 as a clutch. Consistent with the teachings of Meyer, Engles teaches that it
3 was known in the art to package auto parts, such as spark plugs. (Engle,
4 Example 1).

5 Applicants contend that Engles fails to remedy the deficiencies of
6 Meyer. Applicants' state that Engles rejects paperboard as an effective
7 backing for its packaging.

8 Obviousness is not limited to the express teachings of a single prior
9 art reference but is based upon what the *combined* teachings of the prior art
10 suggest to the person of ordinary skill in the art. *In re Keller*, 642 F.2d 413,
11 425, 208 USPQ 871, 881 (CCPA 1981)("The test for obviousness is not
12 whether the features of a secondary reference may be bodily incorporated
13 into the structure of the primary reference; nor is it that the claimed
14 invention must be expressly suggested in any one or all of the references.
15 Rather, the test is what the combined teachings of the references would have
16 suggested to those of ordinary skill in the art.").

17 Meyer teaches a method of packaging a metal automotive part to
18 protect it from corrosion. Consistent with this teaching, Engles teaches that
19 it was known in the art to package auto parts. We affirm the Examiner's
20 rejection of claim 3 as obvious over Meyer in view of Engles.

21
22 V. The Rejection of Claim 4 Under 35 U.S.C. § 103(a) as being
23 unpatentable over Meyer in view of Engles and further in view
24 of Kean
25

26 Applicants' claim 4 depends from claim 1 and requires that the
27 automobile part to be packaged is one or more of window glass, door panel,
28 hood or fender.

1 Meyer teaches that various metal automobile parts may be protected
2 from corrosion by shrink wrapping the part to paperboard. Kean teaches that
3 glass sheets may be packaged to protect against breakage and weathering
4 during transportation.

5 Applicants contend that Kean fails to teach or suggest shipping a
6 single piece of glass. (Br. at 17). Applicants also contend that Kean
7 describes a relatively complicated packaging method. (*Id.*). Applicants
8 conclude that the combination of Meyer and Kean teach away from the
9 claimed invention.

10 Meyer teaches one of ordinary skill in the art that any metal
11 automotive part may be protected from corrosion by shrink wrapping the
12 part to paperboard. A person of ordinary skill in the art would know that
13 door panels, hoods and fenders are metal automotive parts that are subject to
14 corrosion. One of ordinary skill in the art would have been guided to use
15 Meyer's packaging method for a metal automotive part, such as a fender or
16 hood, to protect the part from corrosion damage. Kean does not teach
17 otherwise. We find that Applicants' selection of a fender, hood or door as
18 the metal automotive part to be packaged in Meyer represents nothing more
19 than the predictable use of prior art elements in a known manner according
20 to their established function. We affirm the Examiner's rejection of claim 4
21 as obvious over Meyer in view of Engles and further in view of Kean.

22

1 VI. The Rejection of Claim 5 Under 35 U.S.C. § 103(a) as being
2 unpatentable over Meyer in view of Wilkinson
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4 Applicants' claim 5 depends from claim 1 and requires that the shrink
5 wrapped automobile part of claim 1 be placed in a container.

6 Applicants do not dispute that placing a shrink wrapped part in a
7 package was unknown to one of ordinary skill in the art. Instead, Applicants
8 contend that Wilkinson does not make up for the deficiencies of Meyer and
9 that claim 5 is patentable for the same reasons claim 1 is patentable. (Br. at
10 17).

11 We affirmed the Examiner's rejection of claim 1 as anticipated by
12 Meyer. We affirm the Examiner's rejection of claim 5 for the reasons
13 provided above with respect to Meyer and further in view of the undisputed
14 Examiner's finding that placing a package in a container was known in the
15 art.

16
17 CONCLUSION

18 Upon consideration of the record and for the reasons given, it is:

19 Ordered that the Examiner's rejection of claims 1 and 24 under
20 35 U.S.C. § 102(b) as being anticipated by Meyer is AFFIRMED.

21 Ordered that the Examiner's rejection of claim 2 under 35 U.S.C.
22 § 103(a) as obvious over Meyer in view of Gillio-tos is AFFIRMED.

23 Ordered that the Examiner's rejection of claim 3 under 35 U.S.C.
24 § 103(a) as obvious over Meyer in view of Engles is AFFIRMED.

25 Ordered that the Examiner's rejection of claim 4 under 35 U.S.C.
26 § 103(a) as obvious over Meyer in view of Kean is AFFIRMED.

27 Ordered that the Examiner's rejection of claim 5 under 35 U.S.C.

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- 1 § 103(a) as obvious over Meyer in view of Wilkinson is AFFIRMED.
- 2 Further Ordered that no time period for taking any subsequent action
- 3 in connection with this appeal may be extended under 37 C.F.R.
- 4 § 1.136(a)(1)(iv)(2006).

AFFIRMED

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